REMARKS

Initially, it should be noted that this Response After Final should be entered and considered without an RCE. As we discussed by telephone on May 25, 2007 and as noted in detail below, claims presented in the previous Amendment "A", filed Feb. 21, 2007, have not been fully or adequately considered. In particular, elements of claims which were presented in the previous amendment were not considered and elements which were not recited in the claims as presented were considered. Further, a data structure claim was mischaracterized as a computer product embodiment of a method and should be reconsidered, as recited, as a data structure encoded upon a computer-readable medium. Additionally, errors of law as to the patentability of data structures encoded upon computer-readable media have been made and should be corrected.

The Final Office Action, mailed May 3, 2007, considered claims 1–34. Claims 1–34 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, in that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 24–25 were rejected under 35 U.S.C. § 101 as being directed to nonfunctional descriptive material. Claims 1, 4–8, 10 and 11 were rejected under 35 U.S.C. § 102(a) as being anticipated by Zan Ouyang et al., *Cluster-Based Delta Compression of a Collection of Files*, WISE '02 (Aug. 2002) (hereinafter Zan). Claims 12, 24–28 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Zan. Claims 2, 29, 32 and 33 were rejected under 35 U.S.C. § 102(a) as being unpatentable over Zan in view of Forbes et al., U.S. Patent No. 6,381,742 (filed Jun. 19, 2998) (hereinafter Forbes). Claims 3 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zan, in view of Henry, U.S. Patent No. 6,131,192 (filed Jun. 18, 1998) (hereinafter Henry). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zan, in view of MARK ALLEN WEISS, DATA STRUCTURES & ALGORITHM ANALYSIS IN C++ (2d ed., 1999) (hereinafter Weiss). Claims 13, 14, 15 and 21–23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zan, in view of Sliger et al., U.S. Patent No. 6,216,175 (filed Jun. 8, 1998) (hereinafter Sliger). Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zan, in view of Sliger, and in

further view of Forbes. Claims 18–20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zan, in view of Sliger, and in further view of Henry.[1]

By this response, no claims are amended and claims 1–34 remain pending. Claims 1, 13, 24, and 34 are independent claims which remain at issue. As to the 35 U.S.C. §§ 102 &103 rejections, the Applicants respectfully submit that the claims as amended and presented in the previous amendment have not been fully or adequately considered. The Applicants also submit that, as to the 35 U.S.C. § 101 rejections, the applicable law has been inaccurately stated and improperly applied. As to the 35 U.S.C. § 112 rejections, the Applicants submit that the Specification provides adequate enablement for the claims as presented. Accordingly, the Applicants respectfully traverse the rejections and request favorable reconsideration.

Claim rejections under 35 U.S.C. § 112:

Examiner rejected independent claims 1, 13, and 24 (as well as their dependent claims) under 35 U.S.C. § 112 for failing to comply with the enablement requirement.[2] The Applicants respectfully disagree.

The Examiner asserted that "synthesizing a base file based upon package size" is not defined in the Specification.[3] The Applicants submit that ¶¶ 13–15, 35, 40, 57–58, and Fig. 7, when taken in combination with the entirety of the Specification, provide the requisite enablement by providing sufficient information that one of ordinary skill in the art can make and use the invention as claimed.

The Examiner asserted that "generating a list of prospective delta inputs, including an entry for each unique source file in the plurality of source files" is not defined by the Specification.[4] The Applicants submit that ¶¶ 13-14, 33 "Intra-Package Delta Compression" *et seq.*, and 51–52 *et seq.*, when taken in combination with the entirety of the Specification, provide the requisite enablement

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[1] Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

[2] Office Communication p. 4 (paper no. 20070426, May 3, 2007).

[3] Office Comm. p. 4.

[4] Office Comm. p. 4.

by providing sufficient information that one of ordinary skill in the art can make and use the invention as claimed.

Because, as particularly pointed out above, the Specification does provide adequate enablement for one of ordinary skill in the art to make and use the invention as claimed, a rejection under 35 U.S.C. § 112 would be improper and should be withdrawn. The Applicants respectfully request favorable reconsideration.

Claim rejections under 35 U.S.C. § 101:

The Examiner rejected claims 24–25 and 29–33 under 35 U.S.C. § 101 because, in the Examiner's words, "those claims refer to a computer-readable medium having only stored thereon a data structure (data structure Per Se.), which is nonfunctional descriptive material"[5] and the Examiner concluded that "therefore the . . . claims are non-statutory."[6] The Applicants submit that the claims do, indeed, recite statutory subject matter and that such a conclusion that they are proper subject matter under 35 U.S.C. § 101 is clearly supported by both the MPEP and applicable law.

MPEP § 2106.01 recites that "Data structures *not claimed as embodied in computer-readable media* are descriptive material *per se* and are not statutory. . . ."[7] However, it also states that "In contrast, a claimed *computer-readable medium encoded with a data structure* defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and *is thus statutory*."[8]

Claims 24–25 and 29–33 do indeed recite a "computer-readable medium having stored thereon a data structure . . . ." As pointed out above in the clear text of the MPEP, a computer-readable medium encoded with a data structure is proper statutory subject matter and "is thus statutory."[9] Therefore, claims 24–25 and 29–33 should indeed be considered statutory.

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[5] Office Communication p. 5 (paper no. 20070426, May 3, 2007) (emphasis omitted).

[6] Office Comm. p. 5 (emphasis omitted). The Examiner also apparently asserts that a data structure must be accompanied by a computer program to be considered statutory. *See* Office Comm. p. 3. This also misstates the applicable law.

[7] MPEP § 2106.01 I (emphasis added).

[8] MPEP § 2106.01 I (emphasis added).

[9] MPEP 2106.01 I.

Because, as pointed out above, the claims do recite statutory subject matter, a rejection under 35 U.S.C. § 101 of claims 24–25 and 29–33 is improper and should be withdrawn. The Applicants respectfully request favorable reconsideration.

Claim rejections under 35 U.S.C. § 102:

The Examiner rejected claims 1, 4–8, 10 and 11 under 35 U.S.C. § 102 as being anticipated by Zan.[10] The Applicants submit that Zan fails to teach each and every element as set forth in the claims, that Zan fails to show the identical invention in as complete detail as is contained in the claims, and that Zan fails to show the elements being arranged as required by the claim.[11]

In particular, the Applicants submit that Zan fails to teach "synthesizing a base file based upon package size." Notably, the Examiner has not even asserted that Zan teaches such an element. Further, the Examiner asserted that Zan teaches "selecting a source file as a base file," but it should be noted that no such element is recited in claim 1. Because elements recited in the claim were not considered by the Examiner and because elements which were not present in the claim were considered by the Examiner,[12] the Applicants submit that the Examiner has not fully or adequately considered the claim as it was presented. Further, since each and every element as set forth in the claims must be taught by a single reference, since the identical invention in as complete detail as is contained in the claims must be shown by the reference, and since the elements must be arranged in the reference as required by the claim, then omitting elements of the claim from consideration and including elements not recited in the claim in the consideration makes the conclusion of anticipation by Zan improper.

Because the claims as recited have not been fully considered, because it has not been asserted that Zan teaches each and every element as set forth in the claims, because Zan fails to show the identical invention in as complete detail as is contained in the claims, and because Zan fails to show the elements being arranged as required by the claim, a rejection of claim 1 under 35 U.S.C. § 102 in view of Zan is improper and should be withdrawn. The Applicants submit that claim 1 is in condition for allowance as currently recited and respectfully request favorable reconsideration. Since claims 2–12 depend on claim 1, those claims, too, were improperly rejected as being based

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[10] Office Comm. p. 6.

[11] See MPEP § 2131; *see also Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

[12] See Office Comm. p. 6–7.

(at least in part) upon the rejection of claim 1. The Applicants submit that claims 2–12 are in condition for allowance and respectfully request favorable reconsideration.

Claim rejections under 35 U.S.C. § 103:

The Examiner rejected claims 12, 24–28, and 34 under 35 U.S.C. 103(a) as being unpatentable over Zan.[13] The Examiner asserted that "claims 12 and 24 are computer product version for performing the claimed method as in claim 1 . . . wherein all claimed limitation functions have been addressed and/or set forth above . . . ."[14]

Claim 12 is a computer program product embodiment of the method recited in claim 1. However, as discussed above, it has not been shown that Zan teaches each and every element as set forth in claim 1, it has not been shown that Zan shows the identical invention in as complete detail as is contained in claim 1, and it has not been shown that Zan shows the elements being arranged as required by claim 1. Because it has not been shown that claim 1 is anticipated by Zan, it would be improper to reject claim 12 under the same rationale.

Because claim 12 is an alternative embodiment of the method of claim 1 and claim 1 has not been properly rejected, a rejection of claim 12 under the same rationale would be improper and should be withdrawn. The Applicants respectfully request favorable reconsideration.

The Examiner rejected claim 24 asserting that claim 24 was a "computer product version for performing the claimed method as in claim 1."[15] Claim 24 is not, however, as the Examiner asserts, a computer product version of the method of claim 1. In contrast, claim 24 is a computer-readable medium having stored thereon a data structure comprising a first set of data and a second set of data wherein each set of data has a particular structure. Claim 24 is a claim for a data structure and it has not been asserted that the elements of the data structure of claim 24 are taught by any reference. Because it has not been asserted that each and every element of claim 24 is taught or suggested by any combination of prior art references, a rejection under 35 U.S.C. 103(a) is improper and should be withdrawn. The Applicants respectfully request favorable reconsideration.

Because the rejections of claims 25–33 rely (at least in part) on the improper rejection of claim 24 as a computer product version of the method of claim 1, those rejections, too, are improper and should be withdrawn. The Applicants respectfully request favorable reconsideration of claims 25–33.

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[13] Office Comm. p. 9.
[14] Office Comm. p. 9–10.
[15] Office Comm. p. 9–10.

Claims 13–15 and 21–23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zan in view of Sliger.[16] The Applicants submit, however, that Zan and Sliger fail to teach or suggest each and every element of the claims as recited.

In particular, Zan and Sliger fail to teach or suggest receiving a package comprising at least one base file and a plurality of deltas, the base file having been synthesized based upon package size. As was discussed above in connection with claim 1, it has not been asserted that a base file is synthesized based upon package size. Furthermore, Zan and Sliger fail to teach or suggest synthesizing a target file by applying *a delta included in the package* to the at least one *base file included in the package*. Sliger notably teaches away from the delta and the base file being included in the package.[17] Sliger specifically teaches that "the *user's copy* of the old file [is] used to pre-initialize a decompressor to which the patch file is then input."[18] The portion of Sliger cited by the Examiner for teaching these particular elements teaches only that a "patch file is transferred to the user's computer" and that the "compressed data in patch file (sic) is then applied to a decompressor."[19] Therefore, Sliger clearly teaches away from a base file and a delta being included in a package.

The Examiner cited to Zan for "generat[ing] a plurality of deltas and base files in a package"[20] but the portion of Zan cited by the Examiner reads only that:

"we are interested in using delta compression to better compress large collections

of files where it is not obvious at all how to efficiently identify appropriate

reference and target files."[21]

It is clear that the cited passage (as well as the entirety of Zan and Sliger) fails to teach or suggest that a base file and a delta are included within the same package. Being "interested in . . . delta compression" teaches nothing about the arrangement of base files or deltas within packages. The Applicants submit that mere mention of "reference and target files," without any discussion of their location, fails to rise to the level necessary to teach that a base file and a delta is included in the same *package*.

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[16] Office Comm. p. 15.

[17] Notably, the limitation that the base file and delta were included in the package had been added in the previous amendment in view of the Sliger reference.

[18] Sliger, Abstract.

[19] Sliger col. 7 l. 40–48.

[20] Office Comm. p. 15.

[21] Zan p. 1, right column, l. 23–26.

Because it has not been shown that the prior art reference (or references when combined) teach or suggest all the claim limitations,[22] a rejection of claim 13 under 35 U.S.C. 103(a) would be improper and should be withdrawn. The Applicants respectfully request favorable reconsideration. Because claims 14–23 rely on the rejection of claim 13, those claims, too, are improperly rejected under 35 U.S.C. 103(a) and those rejections should be withdrawn. The Applicants respectfully request claims 14–23 also be favorably reconsidered.

The Examiner rejected claim 34 under 35 U.S.C. 103(a) as being unpatentable over Zan.[23] The Examiner asserted that claim 34 "is a system version for performing the method as in claim 1 . . . wherein all the claim limitation functions have been addressed [in the discussion of claim 1]."[24] Firstly, the system of claim 34 does not embody a method identical in elements and scope as the method of claim 1. Further, as was discussed above in reference to claim 1, the Examiner did not consider all the elements recited in claim 1 but did considered elements which were not present in the claim. As to claim 34, itself, the Examiner did not consider the element "synthesizing a base file, the base file having been synthesized based upon package size, from which a source file may be synthesized by applying a delta."

Because claim 34 as recited was not fully considered, it has not been shown that each and every element is taught or suggested by a reference (or references combined). Accordingly, the Applicants submit that a rejection under 35 U.S.C. 103(a) is improper and should be withdrawn. The Applicants respectfully request favorable reconsideration.

In view of the foregoing, Applicants submit that rejections of each of the independent claims, 1, 13, 24, and 34 should be withdrawn and that each of the independent claims 1, 13, 24, and 34 are in condition for allowance. Correspondingly, the Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the

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[22] MPEP § 2143.
[23] Office Comm. p. 9.
[24] Office Comm. p. 11.

last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at 801-533-9800.

Dated this 3rd day of July, 2007.

Respectfully submitted,

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